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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/120,105 09/10/93 WINTER

A HOE92F294

EXAMINER

IM52/0306

CONNOLLY AND HUTZ
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WILSON, D.
ART UNIT

PAPER NUMBER

22

1713
DATE MAILED:

03/06/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	08/120,105	WINTER ET AL.	
	Examiner D. R. Wilson	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 26 December 2000.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 15, 17-19, 21-25 and 27-31 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 15, 17-19, 21-25 and 27-31 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____

18) Interview Summary (PTO-413) Paper No(s) _____

19) Notice of Informal Patent Application (PTO-152)

20) Other: _____

DETAILED ACTION

Response to Amendment

1. Applicant's amendment and declaration filed 12/26/00 has been fully considered with the following results.
2. The amendment overcomes the outstanding objections to new matter and corresponding rejections under 35 U.S.C. § 112, first paragraph, and the objections and rejections are withdrawn.
3. The amendment overcomes the rejections under 35 U.S.C. § 112, first paragraph, and the rejections are withdrawn except in regards to enablement for the DSC characterization of the polymers, and in this regard the rejection is maintained as is discussed below.
4. The rejections under 35 U.S.C. § 112, second paragraph, are overcome by the amendment and the rejections are withdrawn except in regards to: (i) the melting peak being referenced in Claim 17, (ii) the indefiniteness of the olefin of formula $R^aCH=CHR^b$, (iii) the first metallocene in Claim 23, and (iv) the definitions of R^{11} and R^{12} , when they are connected to form a ring in Claim 24, and in this regard the rejections are maintained for the reasons discussed below.
5. The rejection of claims under 35 U.S.C. § 112, fourth paragraph, and the objection of the claims, are overcome by the amendment and the rejection and objection is withdrawn.
6. The amendment overcomes the prior art rejections over (i) EP'374, and (ii) over EP'046 and/or WO'414, optionally further taken with EP=189 and Kaminsky, and these rejections are withdrawn.
7. The obviousness double patenting rejection was not addressed by applicant and is maintained as summarized below.
8. Applicant has also not addressed the objection to the disclosure and minor informalities which are also maintained as is summarized below.

Previously Cited Statutes

9. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
10. The amendment filed 12/26/00 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the

disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The scope of what is being claimed in new Claim 30 is not supported by Examples 1 and 23 as alleged by applicant as these Examples only concern polypropylene and a propylene/ethylene copolymer.

11. Applicant is required to cancel the new matter in the reply to this Office Action.

35 U.S.C. § 112, First Paragraph, Rejection

12. Claim 30 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The subject matter in question is that discussed in the above section.

13. Claims 15, 17-19, 21-25 and 27-31 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant depends on DSC characterization of the melting behavior of components of the blend, as well as that of the blend itself, in regards to both melting peak and width of the melting point endotherm. The crystallinity of both the components and the blend would be expected to be a function of the thermal history of the materials, yet the specification provides no data on thermal conditioning of the samples prior to measurement. (See for example the discussion in EP'189 regarding thermal fusion data as a function of thermal history). The basis of this rejection was stated in Detailed Action § 5(b) of the previous Office Action. Applicant traverses the rejection arguing that reciting the DSC spectrum is determined with a heating/cooling rate of 20°C is sufficient to a person of ordinary skill in the art to repeat the measurement is not deemed to be persuasive. Applicant's reliance on the Ser van der Ven reference is also not deemed to be persuasive. Note that the reference states an opinion of what is most frequently used, not what is always used, and the specification does not teach that this is the method used. It also does not address variation in peak widths that would be expected to be a function of sample size and machine response. Applicant has also not addressed how peak widths are determined for those samples having multiple peaks which are not resolved

35 U.S.C. § 112, Second Paragraph, Rejection

14. Claims 15, 17-19, 21-25 and 27-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. The language of Claim 17 is indefinite because:

a. A bimodal or multimodal melting range would have more than one melting peak and it is indefinite as to which peak "the melting peak" refers. If there must be melting points differing by at least 5/C, then the claimed melting range must be at least bimodal. The basis of this rejection was stated in Detailed Action § 6(a)(iii) of the previous Office Action. Applicant's argument that "the melting peak" would be the maximum peak of a multimodal composition is not deemed to be persuasive because there is no such definition in the specification as filed. Further any argument that the difference in melting points of the polymers refers to the fractionated polymeric components is not supported by the claim language.

b. In the olefin of formula $R^aCH=CHR^b$, R^a or R^b cannot be an alkyl of 1 carbon atom when the other R^a or R^b is hydrogen, i.e., it cannot be propylene. Further, the definition of R^a or R^b when connected to make a ring is not specified, nor could they form a ring if they are hydrogen. The basis of this rejection was stated in Detailed Action § 6(a)(iv) of the previous Office Action and the merits of the rejection have not been addressed by applicant.

c. The language at lines 11-13 is not understood, i.e., "--- wherein the portion of ethylene on the polymerized monomer is so chosen that the ethylene content ---". It is suggested that this be substituted by "--- wherein the polymerized ethylene content ---".

d. The definition of R^3 and R^4 "--- where the substituents ---- form together with the atoms connecting them a ring", because it can't be told which atoms are connected together.

e. The last line of the claim is indefinite because the meaning of "is a substituted indenyl or fluorenyl group which is optional substituted" is not understood. It is suggested that "which is optional substituted" be deleted.

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16. Claim 23 is indefinite because it is not known whether the first listed metallocene is a racemic or a meso compound. The basis of this rejection was stated in Detailed Action § 6(c) of the previous Office Action and the merits of the rejection have not been addressed by applicant.

17. Claim 24 is indefinite because it is not known what the definitions are of R¹¹ and R¹², when they are connected to form a ring. The basis of this rejection was stated in Detailed Action § 6(d) of the previous Office Action. Applicant traverses the rejection arguing that "the carbon group would be connected together to form a ring" is not deemed to be persuasive because the claim does not specify what atoms are connected together to form a ring.

Obviousness Double Patenting

18. Claims 15, 17-19, 21-25 and 27-31¹ are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 5,700,886 (Winter'886). The basis of this rejection was stated in Detailed Action § 11 of the previous Office Action. Applicant has not addressed the merits of this rejection.

Objections to the Disclosure and Minor Informalities

19. The disclosure is objected to because of the following informalities:

- a. At page 13, lines 28-32, the specification teaches that the compositions produced by the process of the invention have melting points of 20 to 80°C. This is clearly outside of the scope of the invention and appears to be some type of misprint.
- b. Comparison Examples 1 and 2 appear to have little meaning as no data is presented for the resulting blends.
- c. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
- d. The abstract of the disclosure is objected to because it is more than one paragraph and should be restricted to recite a process. Correction is required. See MPEP § 608.01(b).

¹ The Examiner acknowledges that Claim 28 was not included in the previously stated rejection. However, this is believed to be an obvious oversight as the further subject matter of Claim 28 is clearly within the teaching of Winter'886.

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20. Appropriate correction is required.

Action Is Final

21. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

22. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Other Comments

23. There appears to be no antecedent basis in Claim 17, for R⁵ in Claim 28 being ethylene. A rejection is not being made at this time as the outstanding rejections are still believed to be valid.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-892-9311 for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.



D. R Wilson
Primary Examiner
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